

**REMARKS**

Claims 1-12, 14-32 and 34-40 are currently pending in the application. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

***Improper Final Rejection***

Applicants submit that the finality of the present office action is improper. According to MPEP 706,

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.

....

Additionally, MPEP 706.07(a) notes:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art..

To this end, Applicants note that the Examiner, in the office action dated June 30, 2006, did not provide any reasons for rejection of claim 38. This was brought to the Examiner's attention in the response of August 22, 2006. See, e.g., page 10. This being the case, a "clear issue [was not] developed between the examiner and applicant". Also, the rejection of claim 38 (in the present office action) is a new ground of rejection that was neither necessitated by Applicants' amendment of the claims nor based on information submitted in an information disclosure statement.

Thus, the Examiner has not provided Applicants with a fair opportunity to respond to a rejection of claim 38, as presented in the present office action. Accordingly, Applicants request withdrawal of the finality of the present office action.

### ***Objection to Claims***

Claim 18 was objected to for failing to further limit the subject matter of a previous claim. In response, claim 18 recites a prefabricated sectioned approach section totally filling an area of the bowling lane in addition to gutter area. This language limits the subject matter of claims 17 and 1, which do not recite these features. Accordingly, Applicants request withdrawal of the objection.

### ***35 U.S.C. §102 Rejection***

Claims 1, 8, 9, 12, 19, 24, 25, 30, 31, and 37-39 were rejected under 35 U.S.C. §102(b) for being anticipated by U. S. Patent No. 2,969,983 issued to De Vore. This rejection is respectfully traversed.

First, Applicants wish to thank the Examiner for a thorough explanation of his position. This explanation has assisted Applicants' undersigned representative to more thoroughly understand the Examiner's position and respond accordingly.

Prefabricated

Claims 1, 24 and 38 each recite that the flooring system of the recited inventions are prefabricated. It is the Examiner's opinion that the term "prefabricated" connotes no structure and at best should be considered functional language. Additionally, the Examiner provides a very broad interpretation of "prefabricated" to mean "fabricated before use". Applicants submit that this is an overly broad interpretation which is not supported by the common usage as defined in the specification and which would be known to those of skill in the art. The term "prefabricated", as defined by the on-line version of the American Heritage® Dictionary of the English Language interprets "prefabricated" as:

To manufacture (a building or section of a building, for example) in advance, especially in standard sections that can be easily shipped and assembled.

Cleary De Vore does not show this feature. Instead, as is abundantly clear from a fair reading of De Vore, the bowling lane is fabricated at the site of the bowling lane. In fact, due to the construction, it would not even be possible to provide a prefabricated bowling lane. This is due to the fact that the bowling lane is built in half sections, using a complex structure of planks, 61, 62, wires 69 and bar clamps 57 and 58. In addition, the way that the flooring assembly is required, a space 56 down the center of the alley is created between the two halves so that the bar clamps 57 and 58 can respectively clamp its half of the floor. This space needs to be completed on site, which requires the placement and gluing of a center wood board between the two halves. This clearly shows that the De Vore system cannot be prefabricated in accordance with the invention.

Also, despite the Examiner's assertion to the contrary, the term "prefabricated" does connote a structure and is not merely functional. For example, the prefabricated system of the claimed invention connotes a single flooring system which can easily be

installed at site. This is contrary to the flooring system of De Vore which must be assembled on site, using a complex system of clamps, wires, planks, gluing, etc.

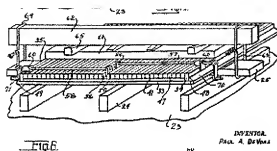
Being more specific, in De Vore, the flooring panels 47 are bonded to an upper baseboard. As disclosed at col. 4,

The alley boards ... 47, are located between the side boards 34 and 35, and said side boards 34 and 35 are secured to the baseboard by adhesive of a suitable and desirable character of which various forms are on the market. As illustrated in Fig. 3 the portions of the sub-baseboard 33 which project laterally of the upper base board 41, said portions ... 48 and 49, having applied thereto, respectively, adhesive 50 and 51. The upper surface of the baseboard 41 has likewise applied thereto adhesive 52 and which adhesive 50, 51 and 52 securely holds the alley boards 47 as well as the side boards 34 and 35 in operative relation to one another and to the supporting base.

Additionally, at col. 5, De Vore discloses:

After the base boards 33 and 41 are secured by the screws 36, 37 and 40 the glue or adhesive 50 and 51 is applied for the distance corresponding to the section of the alley to be laid whereupon the side boards 34 and 35 are mounted and respectively retained in place by their respective retaining strips 70 and 71. The adhesive 52 is then applied to the upper surface of the upper baseboard 41, again for the distance corresponding to the section of the alley to be laid, whereupon one-half, less one board, of the alley boards 47 are then arranged in face contact inwardly from each of said side boards thereby leaving a space 56 longitudinally of the alley and substantially at the center of the alley between the boards.

Also, the complex assembly required for the installation of the flooring system is shown in FIG. 6, as reproduced below and discussed in more detail at col. 5, for example.



Accordingly, it is clear that De Vore only discloses fabricating (i.e., assembling) of the flooring system on site. Additionally, Applicants even doubt, due to the complex nature of the joining method, that the De Vore flooring system could even be prefabricated. This is not only based on the above discussion, but also on the fact that the De Vore flooring system is also secured to respective retaining strips 70 and 71 and rabbit strips, structures which makes the assembly of the flooring system more complex and one which would not be amendable to prefabrication away from the job site.

#### Only One Side

Claims 1, 24 and 38 each recite that the outermost boards of the plurality of wooden boards are bonded only on one side edge by the adhesive to adjacent corresponding interior boards to form a preformed section of wooden boards. More specifically, representative claim 1 recites, in part,

.... outermost boards of the plurality of wooden boards being bonded only on one side edge by the adhesive to adjacent corresponding interior boards to form a preformed section of wooden boards

This feature is not shown in De Vore. In fact, De Vore teaches away from this feature. More specifically, De Vore specifically teaches that the outer most boards are adhered to retaining strips 70 and 71 (as well as to the inner respective boards). See, col. 4, lines 70-74. This is required for the flooring assembly of De Vore, but is not a

requirement of the presently claimed inventions. Accordingly, De Vore does not teach these features of the respective base claims of the present invention and, thus, by definition cannot anticipate the claimed invention.

Approach Lane

Claim 24 is specifically directed to a prefabricated approach section abutting the bowling lane. The prefabricated approach section comprises:

a plurality of wooden boards having a longitudinal axis, the plurality of wooden boards each having side edges along the longitudinal axis, the plurality of wooden boards being bonded together by an adhesive applied on the side edges wherein two of the outermost boards of the plurality of boards are bonded only on one side edge by the adhesive to adjacent corresponding interior boards to form the prefabricated approach section of wooden boards,

the prefabricated approach section having a thickness approximately the same as the bowling lane.

As an approach lane is clearly different than a bowling lane, Applicants submit that the De Vore reference does not show these features. De Vore, throughout the entire disclosure, only speaks of the bowling lane. In fact, Applicants submit that the prefabrication of an approach lane requires other considerations, none of which are even remotely contemplated by De Vore. Instead, De Vore is directed only to a bowling lane, with the specific requirements thereof.

By way of example, in manufacturing an approach lane, there are no gutters, there is a requirement that the flooring system is of the same height (e.g., thickness) as the bowling lane, there are different flooring requirements due to wear issues, etc. None of these considerations seem to be taken into account in De Vore. Despite these other considerations, De Vore is also clearly directed only to a bowling lane as it is placed between the respective gutters. For this reason, amongst others, De Vore clearly does not anticipate claim 24.

Dependent Claims

As to the dependent claims, Applicants submit that many of these features are not shown in De Vore. For example, claim 12 is dependent on claim 11, which recites an MDF and HDF board. De Vore, simply, does not show these materials used in its flooring system. As to claim 30, Applicants submit that De Vore does not show these features, as discussed in detail above with respect to the independent claims.

Also, as claim 11 is rejected under 35 U.S.C. 103(a), it is improper to reject claim 12, which is dependent on claim 11, under 35 U.S.C. 102(b). That is, by definition, the features of claim 12 include the features of claim 11. Noting that claim 11 is not anticipated, it is not possible for claim 12 to be anticipated. For this reason also the rejection of claim 12 is improper and should be withdrawn.

As to claim 37, De Vore makes no mention of dowels used as finders. As to claim 39, there is no disclosure, whatsoever, as discussed above, that De Vore shows an approach area.

Applicants respectfully request that the rejection over claims 1, 8, 9, 12, 13, 19, 24, 25, 30, 31, 33, 37 and 39 be withdrawn.

**35 U.S.C. §103 Rejection**

Claims 2-5, 7, 10, 17, 18, 20-23, 26-29, 32, 35-37 and 40 were rejected under 35 U.S.C. §103(a) for being unpatentable over De Vore. Claims 14-16 and 34 were rejected under 35 U.S.C. §103(a) for being unpatentable over De Vore in view of U. S. Patent No. 5,348,513 to Heddon. These rejections are respectfully traversed.

Applicants submit that each of these rejected claims are dependent on a distinguishable independent claim. According, for this reason, each of the rejected claims under 35 U.S.C. §103(a) should be allowed by virtue of their dependencies on distinguishable independent claims.

Applicants also submit that these claims are allowable on their own merits. By way of example, claims 20 and 35 recite the use of predrilled holes for the use of

fasteners; however, De Vore explicitly teaches away from the use of fasteners and as such would not contemplate the use of predrilled holes for fasteners. In fact, according to De Vore, the use of fasteners contribute, after many years, to the need to replace the floor boards due to sanding of the flooring boards; the exact reason why De Vore had contemplated the use of an adhesive to the underside of the boards. With this said, Applicants are at a loss to see how the use of fasteners would be obvious in the De Vore assembly.

Applicants also submit that the use of different types of materials such as, for example, HDF, MDF, OSB and HDP are not contemplated or suggested by De Vore. Applicants again are at a loss to see how the Examiner can make the rejection based on common knowledge or how De Vore would provide any motivation to make such a substitution of materials. For example, MPEP 2143.01 (III) notes that

... the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

In this case, there is simply no suggestion for the desirability of such combination, nor has the Examiner shown otherwise.

The Examiner is also of the opinion that it is well known to use interleaved finger joint (claim 23) in a bowling lane. Applicants respectfully disagree. There simply is no motivation or suggestion to use such interleaved finger joints in the De Vore reference, especially since the alley is fabricated on site. That is, there would be no need to complicate the already complex assembly in De Vore since the panels are laid at the bowling center, on the bowling lane. Simply, to extend the length of the lane, the installer of De Vore would only have to lay another set of the panels on the underlayment, and complete the above noted gluing procedure.



Accordingly, Applicants respectfully request that the rejection over claims 2-5, 7, 10, 14-18, 20-23, 26-29, 32, 34-37 and 40 be withdrawn.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', is written over a horizontal line.

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